



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

GONIOUKH et al.

Serial No. 10/070,860

Filed: 3/12/2002

For: METAL COMPLEXES AS CATALYSTS FOR THE POLYMERIZATION OF
UNSATURATED COMPOUNDS

Art Unit: 1626

Examiner: Wright, Sonya N.

I hereby certify that this correspondence is being deposited with the
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Person Making Deposit

Signature

Honorable Commissioner of
Patents and Trademarks
Washington, D.C. 20231

PETITION TO THE COMMISSIONER UNDER 37 CFR §1.144

Sir:

Applicants hereby petition to the Honorable Commissioner to review the final
restriction requirement in the above-identified application, dated August 13, 2003.

11/28/2003 BABRAHA1 00000061 10070860

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130.00 OP

STATEMENT OF MATERIAL FACTS

1. This application is a US national stage application filed in the US on March 12, 2002, based on international application PCT/EP00/09076, which was filed on September 15, 2000.

2. In the first office action dated June 6, 2003, the examiner created five claim groupings and limited the range of relevant compounds. The examiner then required election of one of the groupings for further prosecution.

3. Applicants filed a timely response to the restriction requirement on July 2, 2003, electing designated group IV, with traverse, and provided reasons for the traversal of the restriction requirement.

4. In a first office action on the merits, dated August 13, 2003, the examiner maintained the restriction requirement, withdrew claims 15-20 and 24-28 in their entirety, and objected to claims 21-23 for containing non-elected subject matter. No rejections were made on the basis of prior art.

5. Applicants have filed an amendment under 37 CFR §1.111 in response to formalistic issues raised in the examiner's office action, which is of even date with the present petition to the commissioner.

8. Applicants have not yet filed a notice of appeal under 37 CFR §1.191 in this application.

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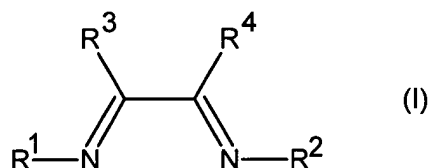
STATUS OF THE CLAIMS

The claims pending in this application are claims 15-31. A copy of the pending claims as amended in applicants' amendment under 37 CFR §1.111 is found in the attached appendix.

REMARKS

The present application is a national stage filing of a PCT application, and is to be examined under unity of invention standards set forward in PCT Rule 13 and the implementing provisions of 37 CFR §1.475. Under these provisions, unity of invention is fulfilled "when there is a technical relationship ... involving one or more of the same or corresponding special technical features."

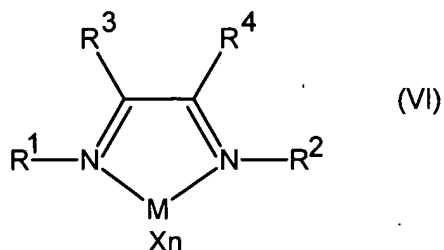
The examiner's defined Group I includes claims 15-18, which are drawn to 1,2-diimines of formula (I)



where R¹ and R² are 5-7 membered rings which include a nitrogen atom at the position marked by R¹ or R², or, alternatively, R² may be alkyl, aryl, or cycloalkyl, and R³ and R⁴ are H, alkyl, aryl, cycloalkyl, or form a 5-8 membered carbocyclic or heterocyclic ring.

Group II includes claim 19 and Group III includes claim 20, each of which is drawn to a process for producing diimines of formula (I).

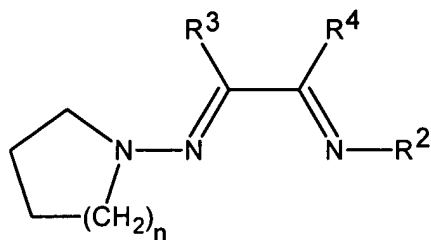
Group IV includes claims 21-23, which are drawn to compounds of the formula (VI)



in which the variables R^{1-4} are as set forward above, and a process of making these utilizing the diimines of formula (I).

The examiner-defined Group V includes claims 24-28, drawn to a process for producing polyolefins utilizing compounds of the formula (VI).

These claims are related through the continued presence of compounds having at least the following core structure in common:

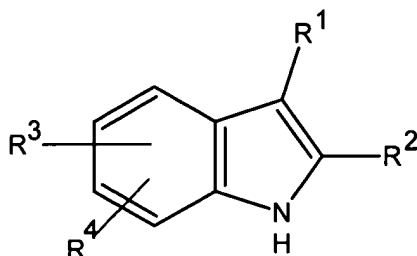


where n is from 1 to 3. This core structure is a "special technical feature" as set forward in Part 1 of Annex B to the PCT. These instructions on determining unity of invention in "Markush-style" claims state that the requirements for unity of invention "shall be considered to be met when the alternatives are *of a similar nature*," *i.e.*, where "all alternatives have a common property or activity, and ... a significant structural element is shared by all of the alternatives" (Annex B, Part 1(f)).

All compounds of formula (VI) show a capacity to catalyze polyolefin production, and all compounds of formula (I) are intermediates suitable for producing these

catalysts. Further, the above-identified common structural core meets the “significant structural element” requirement, as it is “a common chemical structure which occupies a large portion of [each of] their structures” (*id.*).

That the structural element, itself, need not define the invention over the art is articulated through example 18 in the PCT Annex on unity of invention. In that example, the following compound is found to possess unity of invention:



where

R¹ is phenyl, pyridyl, thiazolyl, triazinyl, alkylthio, alkoxy, or methyl;

R²-R⁴ are methyl, benzyl, or phenyl.

The Annex text states that

In this case the indolyl moiety is the significant structural element which is shared by all of the alternatives. Since all the claimed compounds are alleged to possess the same utility, unity is present.

(PCT Annex B, Part 2, Section III, Example 18.) As in the present case, the significant structural element, the indolyl moiety, is not, itself, novel. Nevertheless, the compound is found to possess unity of invention.

The compounds of the present claims meet the requirements for unity of invention as outlined in the PCT instructions. Accordingly, the full range of compounds should be retained and examined. Additionally, as the compounds, together, form a contribution over the prior art, their presence in each of the claim groupings indicates

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that unity of invention is present among all of claims 15-28.

CONCLUSION

In view of the foregoing remarks, it is urged that applicants's claims as presently pending meet the unity of invention requirement as set forth in PCT Rule 13 and 37 CFR §1.475 which is applicable in the present case under PCT Article 27. It is therefore requested that the examiner's restriction requirement be traversed and that the application be returned to the examiner for further examination. It is also respectfully solicited that any unfairness in the compensation of the examiner due to differences between US national restriction practice under 35 USC §121 and unity of invention provisions under the PCT be resolved internally at the USPTO.

Please charge any shortage in fees due in connection with the filing of this paper, including Extension of Time fees to Deposit Account No. 11-0345. Please credit any excess fees to such deposit account.

Respectfully submitted,
KEIL & WEINKAUF

A handwritten signature in black ink, appearing to read 'David C. Liechty', with a long horizontal flourish extending to the right.

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